

Appl. No. : 09/782,534
Filed : February 13, 2001

REMARKS

Claims 6, 8-11, 15-17, 19, 21, 23, 24, 26, 27, 32, and 45-47 were previously cancelled, without prejudice. In the Office Action mailed August 23, 2004, the Examiner withdrew from consideration Claims 7, 12-14, 18, 20, 22, 25, 28-31, 33-44, and 50-52. In the April 20, 2005 Office Action the Examiner acknowledged that Claim 1 has been amended but maintained rejections of Claims 1-5, 48, and 49. In response to the April 20, 2005 Office Action and to facilitate examination of the present application, Applicants cancelled Claims 7, 18, 20, 22, 25 and 28, without prejudice and retaining the option to reintroduce these claims at a later time. Claims 1-5, 48, and 49 are the only claims pending in the present application. In the Office Action dated November 9, 2005, the Examiner maintains rejections of Claims 1-5, 48, and 49, as discussed below.

Claim Rejections - 35 U.S.C. § 103

In the Office Action dated November 9, 2005, the Examiner rejects Claims 1-5, 48, and 49 under 35 U.S.C. § 103(a) as being unpatentable over Reiley et al. (U.S. Patent No. 6,440,138) in view of McFarlane (U.S. Patent No. 4,046,144). The Examiner contends that Reiley discloses all the limitations recited by independent Claim 1 except for the beveled or "shaped" distal end of the anterior tract sheath. Furthermore, the Examiner contends that because McFarlane teaches the use of a beveled distal end of a tubular body for facilitating venipuncture, it would have been obvious to modify the distal end of the anterior tract sheath of Reiley to give it a beveled shape. More particularly, the Examiner states that a bevel-shaped distal end "is well known in the art, as taught by McFarlane, to aid the insertion of discectomy instrument into the body of a patient."

Applicants respectfully traverse these rejections and contend that the Examiner has failed to establish a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness, the Examiner must show:

- (i) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings,
- (ii) a reasonable expectation of success, and
- (iii) the prior art reference or references combined teach or suggest all the claim limitations. (See MPEP § 2142)

Appl. No. : 09/782,534
Filed : February 13, 2001

Applicants do not believe that Reiley and McFarlane suggest or motivate one of ordinary skill in the art to modify either reference or combine them to obtain Applicants' claimed invention.

Nonetheless, Applicants have amended the claims herein to approach the invention from a different perspective, which distinguishes over the cited art.

In particular, Reiley et al. fails to disclose or suggest an assembly including an elongated discectomy instrument which is axially moveable within a cutter sheath, which is in turn axially moveable within an anterior tract sheath. The discectomy instrument has a cutting head which is movable between a laterally extending orientation when unconstrained by the cutter sheath, and an axial orientation when constrained by the cutter sheath.

Although the embodiments of Figures 12, 13 and 14 in Reiley appear to disclose a blade having a laterally extending orientation, Reiley contains no disclosure of reverting that blade to an axial orientation by retraction into a cutter sheath. To the contrary, referring to Figures 15 and 16, the guide sheath 124 in Reiley appears to have a sufficient inside diameter to accommodate the cutting blade 110 without changing it from its lateral orientation.

In view of the foregoing, Applicants respectfully submit that Claim 1 is neither disclosed or suggested by Reiley, and McFarlane fails to suggest modifying Reiley in a manner that would fall within the scope of Applicants' claimed invention.

Claims 2-5, 48, and 49, which depend from Claim 1, are believed to be patentable for the reasons stated above with respect to Claim 1. Applicants respectfully submit that Claims 1-5, 48, and 49 would not have been obvious under 35 U.S.C. § 103(a) and are patentable over Reiley et al. in light of McFarlane. Accordingly, Applicants respectfully request that the rejection of Claims 1-5, 48, and 49 be withdrawn.

In view of the foregoing, Applicants respectfully submit that the pending claims of the present application are in condition for allowance, and such action is earnestly solicited. If, however, any questions remain, the Examiner is cordially invited to contact the undersigned so that any such matter may be promptly resolved.

Appl. No. : 09/782,534
Filed : February 13, 2001

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 4/4/06

By: Gerard von Hoffmann

Gerard von Hoffmann
Registration No. 33,043
Attorney of Record
Customer No. 20,995
(949) 760-0404

2316231
012306